

R 2001-157



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

JAN 5 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading questions 39 and 44 of the morning section and questions 10, 28, 36, 47, and 48 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner originally scored 65. On July 27, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded one additional point for morning question 44 on the Examination. However, no credit has been awarded for morning question 39 and afternoon questions 10, 28, 36, 47, and 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists _____

(A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.

(C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.

(E) None of the above.

The model answer is choice (C).

Selection (C) is the most correct as per MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: "No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent." (E) is incorrect because a (C) is correct.

Petitioner argues that answer (C) is incorrect. Petitioner selected answer (A), however did not present any argument that answer (A) would be the correct answer. Petitioner contends that a claim limitation that is broadened would thereby narrow the claim in comparison to the original and would therefore be permissible.

Petitioner's argument has been fully considered but is not persuasive. The examination instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. As explained in *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998), arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. Accordingly, case law had modified the PTO rules of practice, rendering arguments alone as a cause for surrender of subject matter under recapture.

Contrary to petitioner's statement that a claim limitation that is broadened would thereby narrow the claim in comparison to the original claim, a limitation now being broadened in the present reissue would **broaden** (not narrow) the claim in comparison to the original claim. For example, if a limitation being broadened from a temperature range of 10-100 C to a temperature range of 0-1000 C, the reissue claim would be broader than the original claim. Therefore, the limitation broadened during reissue renders such broadening impermissible recapture. The statement in answer (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner

properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

(A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.

(B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.

(C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.

(D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.

(E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues that there is no correct answer. Petitioner did not present any argument that his selected answer (D) would be correct. Petitioner contends that a practitioner has a duty to represent a client zealously. Petitioner argues that a practitioner should call the examiner as a zealous practice and then do whatever is consistent with PTO practice, and that doing nothing is poor practice and violate 37 C.F.R. § 10.84 and 10.61, Cannon 5. Petitioner also argues that answer (B) is incorrect because claims 2-10 are depended on a rejected independent claim.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that it is good practice to give an examiner a call, the answer (A) specifically states that the attorney should advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled. As explained in 35 USC § 305, reexamination proceedings are conducted with special dispatch. Accordingly, a registered practitioner is charged with knowing that there is no mechanism for suspending a reexamination proceeding until a bankruptcy is settled, rendering answer (A) incorrect because it asserts an action contrary to PTO rules and practices. The issue of bankruptcy is not relevant to the reexamination proceeding. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required. Given that no action is required and a registered practitioner would know not to request suspension of a reexamination proceeding, the statement in answer (B) is correct and the statement in answer (A) is incorrect. As to 37 C.F.R. § 10.84 and 10.61, both sections direct the attorney to exercise professional independent judgement, which is consistent with the stated fact that the attorney agrees with the Examiner's view of the status of the claims.

Answer (B) is correct because accordingly to MPEP 2260.01, if a base patent claim has been rejected in a reexamination, any claim which is directly dependent thereon should be allowed if it is otherwise allowable. The dependent claims should not be objected to or rejected merely because it depends on a rejected or canceled claim. No requirement should be made for rewriting and dependent claim in independent form. Therefore, a reexamination certificate will issue

indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is true?

(A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.

(B) The 2-month period for filing a petition mentioned in 37 C.F.R. § 1.181(f) is extendable under 37 C.F.R. § 1.136(a).

(C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.

(D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.

(E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E).

Selection (E) is correct. See MPEP § 1414 Content of Reissue Oath/Declaration and 37 C.F.R. § 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 C.F.R. § 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 C.F.R. § 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 C.F.R. § 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP § 1206, pages 1200-8 and 9. As to (B), see MPEP § 1002. As to (C), 37 C.F.R. § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Petitioner argues that answer (B) is correct. Petitioner contends that answer (E) is incorrect because the claim for foreign priority is not required to be made in the declaration or oath.

Petitioner also contends that answer (B) is true as per 37 C.F.R. 1.136 which states that an applicant may extend the time period for reply unless one of 5 events occur, and none of the 5 events include filing a petition.

Petitioner's argument has been fully considered but is not persuasive. 37 C.F.R. § 1.63(c) states that the oath or declaration in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55 must identify the foreign application for patent or inventors certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

As indicated by petitioner, 37 C.F.R. § 1.136(a) allows an applicant may extend the time period for reply unless one of 5 events occur, but 37 C.F.R. § 1.136(a) applies to the time period for a required reply to an Office action. A petition is not a required reply and therefore 37 C.F.R. § 1.136(a) is not applicable. Further, 37 C.F.R. § 1.181(f) provides that any petition not filed within 2 months from the action complained of may be dismissed as untimely. MPEP § 1002 further states that the 2 month period is not extendable under 37 C.F.R. § 1.136(a) since the time is within the discretion of the Commissioner, rendering answer (B) incorrect. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 36 reads as follows:

36. Which of the following is **true**?

(A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.

- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.
- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.
- (D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.
- (E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice (B).

Answer (B) is correct, see 37 C.F.R. § 10.11(b), where "the names of individuals so removed will be published in the Official Gazette." The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

Petitioner argues that there is no correct answer to this question. Petitioner did not present any argument for his selected answer (D). Petitioner contends that the answer (B) is not correct because 37 CFR 10.11(b) violates the Due Process Clause of the U.S. Constitution and answer (B) is ultra vires.

Petitioner's argument has been fully considered but is not persuasive. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (D). Furthermore, contrary to petitioner's argument that 37 CFR 10.11(b) violates the Due Process Clause and the answer (B) is ultra vires, the letter sent by the Director

of Enrollment is a notice and the letter is sent for the purpose of ascertaining whether they wish to remain on the register. 37 CFR 10.11(b) also provides that the name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in 37 CFR 1.21(a)(3). No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 47 reads as follows:

47. Which of the following actions, if any, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with proper PTO rules and procedure?

I. Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner.

II. Filing a Notice of Appeal, then a brief, and arguing in the brief the impropriety of the finality of the rejection.

III. Filing a petition under 37 C.F.R. 1.181 based on improper finality of the rejection to stay the running of the period for reply set in the final Office action.

(A) I. only.

(B) II. only.

(C) III. only.

(D) I. and III.

(E) None of the above.

The model answer is choice (A).

MPEP 706.07(c) and (d) set forth that prematureness of a final rejection may not be advanced as a ground for appeal. (II) is therefore improper. (II) is also improper because required fees have not been paid. 37 C.F.R. §§ 1.191 and 1.192. (III) is improper because the filing of the petition does not stay the period for reply. MPEP 1002. Thus, choices (B), (C), and (D) are incorrect. (E) is incorrect because (A) is correct.

Petitioner argues that the answers (A) is incorrect. Petitioner did not present any argument for his selected answer (B). Petitioner contends that MPEP 706.07 renders (I) incorrect because that MPEP section discusses the finality of the rejection instead of tenability of the rejection. Petitioner concludes that answer (A) is incorrect and maintains that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that tenability rather than finality is the appropriate argument in (I), the question specifically asks whether filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with Office rules. As explained in MPEP 706.07, any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. The question does not ask about arguing the merits of the action, but instead arguing about the finality of the action. Accordingly, MPEP 706.07 demonstrates that arguing the finality of a rejection while the application is pending before the primary examiner does comport with Office rules, rendering answer (I) correct. The statement in answer (A) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

(A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.

(B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.

(C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.

(D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

(E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice (D).

(D) is the most correct answer as per 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification..."); MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part of 'As A Whole' Inquiry"). (A) is incorrect. MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry more weight. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). (B) is incorrect. MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). (C) is incorrect. MPEP 2141.02 (section styled, "Distilling The Invention Down To a 'Gist' or 'Thrust' Of An Invention Disregards 'As A Whole' Requirement"). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem). (E) is incorrect. As stated in MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part Of 'As A Whole' Inquiry"), "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993)."

Petitioner argues that answer (B) is correct. Petitioner contends that answer (D) is incorrect because it states that in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are either inherent in the subject matter or disclosed in the specification. Petitioner argues that consideration is not

necessarily given to subject matter that is inherent in the claim. Petitioner contends that answer (B) restates the factual inquiry of *Graham v. John Deere* from MPEP 2142. The Petitioner concludes that answer (D) is incorrect and maintains that answer (B) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (D) is incorrect because it states that in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are either inherent in the subject matter or disclosed in the specification, the question specifically states that consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification. As explained in *In re Antonie*, such consideration is given. Accordingly, the statement in answer (D) is correct. Answer (B) is incorrect because the question under 35 U.S.C. § 103 is whether the **claimed invention as a whole would have been obvious**. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Also see MPEP 2141.02. No error in grading has been shown. Petitioner's request for credit on this question is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr.

In re

Page 14

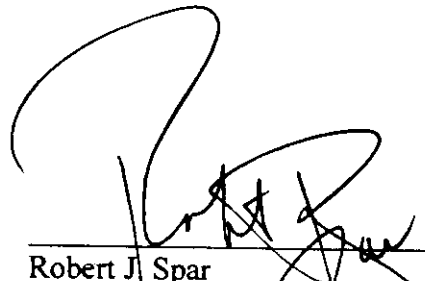
Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy